



PATENT
Docket No. 56401US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#17
P. Allen
10/02/03

Applicant(s): Mark D. SWANSON et al.) Group Art Unit: 3654
Serial No.: 09/818,240) Examiner: John Quoc Nguyen
Confirmation No.: 1590)
Filed: 27 March 2001)
For: ROLL GOODS DISPENSER SYSTEM AND METHODS OF USE

APPELLANTS' BRIEF ON APPEAL

Assistant Commissioner for Patents
Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Brief is presented in support of the Appeal filed March 19, 2003 from the final rejection of claims 1-32 in the above-identified application under 35 U.S.C. §§ 103 & 102 as set forth in the Final Office Action dated November 19, 2002.

This Brief is being submitted in triplicate, as set forth in 37 C.F.R. § 1.192(a). Applicants hereby authorize a charge to Deposit Account No. 13-4895 in an amount sufficient to cover the fee for filing this Brief under 37 C.F.R. § 1.17(f).

I. REAL PARTY IN INTEREST

The real party in interest of the above-identified patent application is the assignee, 3M Innovative Properties Company.

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II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants' Representatives which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-32 are rejected and are the subject of this Appeal (attached as Appendix A).

IV. STATUS OF AMENDMENTS

The present application was filed on March 27, 2001 with claims 1-32.

A first Office Action was issued on June 10, 2002 indicating that claims 1-32 were rejected under 35 U.S.C. § 112, first paragraph; 35 U.S.C. § 112, second paragraph; and 35 U.S.C. § 103 as obvious in view of U.S. Patent No. 474,518 to Bishop.

Applicants responded on September 5, 2002 with arguments as to patentability of the claims. No amendments to the claims were presented.

A Final Office Action was issued on November 19, 2002, finally rejecting claims 1-32 under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 103 as obvious in view of U.S. Patent No. 474,518 to Bishop. The rejection under 35 U.S.C. § 112, second paragraph, was withdrawn.

Applicants responded to the Final Office Action on February 26, 2003 with further arguments as to the patentability of the claims. No claim amendments were proposed.

An Advisory Action issued on March 7, 2003, indicating that the response filed on February 26, 2003 did not place the application in condition for allowance.

As indicated above, Applicants filed a Notice of Appeal on March 19, 2003.

V. SUMMARY OF THE INVENTION

The present invention is directed to roll goods dispenser systems and methods of using the same. All of pending claims 1-32 are found in Appendix A (attached).

Applicants submit that the pending claims are supported by the application as filed. To assist the Board in understanding the invention, however, Applicants provide the following analyses of the claims with respect to some of the illustrative embodiments of the invention described in the application as filed. It should be understood that Applicants reserve the right to show where the claims are additionally supported in the application as filed.

Independent claim 1 recites a roll goods dispenser system 10 that includes a roll 50 of continuous length product with opposing first and second side surfaces 52 and 54 defining a roll diameter and a core 56 defining a central void 58 within the roll 50. *See* Specification, p. 5, lines 19-24 and FIGS. 1-3. Claim 1 further recites a first dispenser guard 20 including a retaining plug 24 protruding from a side shield 22, wherein the side shield 22 covers the entire first side surface 52 of the roll 50 when the retaining plug 24 is located within the central void 58. *See* Specification, p. 6, lines 11-19; p. 7, line 7 to p. 8, line 7; and FIGS. 1-3. The side shield 20 is movable between a closed configuration (FIGS. 1, 3, & 4) and an open configuration (FIG. 2), wherein the side shield 20 in the closed configuration forms a concave shape facing the roll 50, the concave shape defining a volume, wherein the roll 50 occupies at least a portion of the volume, and further wherein the side shield 20 in the open configuration forms a convex shape facing the roll 50. *See also*, Specification, p. 6, line 28 to p. 7, line 6.

Claim 2 depends from claim 1 and recites the side shield 20 is biased in either the open configuration (FIG. 2) or the closed configuration (FIG. 3), whereby a force is required to move the side shield between the open configuration and the closed configuration. *See* Specification, p. 6, line 28 to p. 7, line 6; p. 8, line 27 to p. 9, line 17.

Claim 3 depends from claim 1 and recites that the retaining plug 24 is friction fit within the central void 58. *See* Specification, p. 7, lines 7-16 and FIG. 3.

Claim 4 depends from claim 1 and recites a second dispenser guard 30 including a retaining plug 34 protruding from a side shield 32, wherein the side shield 32 of the second dispenser guard 30 covers the entire second side surface 54 of the roll 50 when the retaining plug 34 of the second dispenser guard 30 is located within the central void 58. *See* Specification, p. 6, lines 11-19; p. 7, line 7 to p. 8, line 7; and FIGS. 1-3.

Claim 5 depends from claim 4 and recites that at least one retaining plug of the first dispenser guard 20 and the second dispenser guard 30 is friction fit within the central void 58. *See Specification*, p. 7, lines 7-16 and FIG. 3.

Claim 6 depends from claim 4 and recites that the retaining plug 24 of the first dispenser guard 20 is attached to the retaining plug 34 of the second dispenser guard 30. *See Specification*, p. 7, lines 14-16 and FIG. 2.

Claim 7 depends from claim 4 and recites that the side shield 22 of the first dispenser guard 20 and the side shield 32 of the second dispenser guard 30 form an enclosed volume containing the roll 50. *See Specification*, p. 6, line 28 to p. 7, line 2 and FIGS. 1 & 3.

Claim 8 depends from claim 7 and recites that the side shield 22 of the first dispenser guard 20 is movable between a closed configuration (FIGS. 1 & 3) and an open configuration (FIG. 2), wherein the side shield 22 forms a concave shape (FIGS. 1 & 3) facing the first side surface 52 of the roll 50 when in the closed configuration, the concave shape defining a volume, wherein the roll 50 occupies at least a portion of the volume. *See also*, *Specification*, p. 6, line 28 to p. 7, line 6.

Claim 9 depends from claim 8 and recites that the side shield 22 of the first dispenser guard 20 forms a convex shape (FIG. 2) facing the first side surface 52 of the roll 50 when the side shield 22 of the first dispenser guard 20 is in the open configuration. *See also*, *Specification*, p. 6, line 28 to p. 7, line 6.

Claim 10 depends from claim 1 and recites that the continuous length product 50 is adhesive tape. *See Specification*, p. 5, lines 25-27 and FIGS. 3 & 4.

Independent claim 11 recites a roll goods dispenser system 10 that includes a roll 50 of continuous length product with opposing first and second side surfaces 52 and 54 defining a roll diameter and a core 56 defining a central void 58 within the roll 50. *See Specification*, p. 5, lines 19-24 and FIGS. 1-3. The system also includes a first dispenser guard 20 with a first retaining plug 24 protruding from a first side shield 22, wherein the first side shield 22 covers the first side surface 52 of the roll 50 when the first retaining plug 24 is located within the central void 58. *See Specification*, p. 6, lines 11-19; p. 7, line 7 to p. 8, line 7; and FIGS. 1-3. The first side

shield 22 is movable between a closed configuration (FIGS. 1 & 3) and an open configuration (FIG. 2), wherein the first side shield 22 forms a concave shape facing the first side surface 52 of the roll 50 when in the closed configuration, the concave shape defining a volume, and further wherein the roll 50 occupies at least a portion of the volume. *See also*, Specification, p. 6, line 28 to p. 7, line 6.

Independent claim 11 also recites a second dispenser guard 30 including a second retaining plug 34 protruding from a second side shield 32, wherein the second side shield 32 covers the second side surface 54 of the roll 50 when the second retaining plug 34 is located within the central void 58. *See* Specification, p. 6, lines 11-19; p. 7, line 7 to p. 8, line 7; and FIGS. 1-3. The second side shield 32 is movable between a closed configuration (FIGS. 1 & 3) and an open configuration (FIG. 2), wherein the second side shield 32 forms a concave shape facing the second side surface 54 of the roll 50 when in the closed configuration, the concave shape defining a volume, and further wherein the roll 50 occupies at least a portion of the volume. *See also*, Specification, p. 6, line 28 to p. 7, line 6.

Claim 12 depends from claim 11 and recites that the first side shield 22 is biased in either the open configuration (FIG. 2) or the closed configuration (FIGS. 1 & 3), whereby a force is required to move the first side shield 22 between the open configuration and the closed configuration, and further wherein the second side shield 32 is biased in either the open configuration (FIG. 2) or the closed configuration (FIGS. 1 & 3), whereby a force is required to move the second side shield 32 between the open configuration and the closed configuration. *See* Specification, p. 6, line 28 to p. 7, line 6; p. 8, line 27 to p. 9, line 17.

Claim 13 depends from claim 11 and recites that the first side shield 22 forms a convex shape (FIG. 2) facing the first side surface 52 of the roll 50 when in the open configuration, and further wherein the second side shield 32 forms a convex shape (FIG. 2) facing the second side surface 54 of the roll 50 when in the open configuration. *See* Specification, p. 6, line 28 to p. 7, line 6.

Claim 14 depends from claim 11 and recites that at least one of the first retaining plug 24 and the second retaining plug 34 is friction fit within the central void 58. *See* Specification, p. 7, lines 7-16 and FIG. 3.

Claim 15 depends from claim 11 and recites that the first retaining plug 24 is attached to the second retaining plug 34. *See* Specification, p. 7, lines 14-16 and FIG. 2.

Claim 16 depends from claim 11 and recites that the first side shield 22 and the second side shield 32 form an enclosed volume containing the roll 50 when both the first side shield 22 and the second side shield 32 are in their respective closed configurations. *See* Specification, p. 6, line 28 to p. 7, line 2 and FIGS. 1 & 3.

Claim 17 depends from claim 11 and recites that the continuous length product 50 is adhesive tape. *See* Specification, p. 5, lines 25-27 and FIGS. 3 & 4.

Independent claim 18 recites a method of dispensing continuous length product from a roll 50, the method including providing a roll 50 of continuous length product with opposing first and second side surfaces 52 & 54 defining a roll diameter and a core 56 defining a central void 58 within the roll 50. *See* Specification, p. 5, lines 19-24 and FIGS. 1-3. The method further includes providing a first dispenser guard 20 including a retaining plug 24 protruding from a side shield 22, the retaining plug 24 being located within the central void 58 of the roll 50. *See* Specification, p. 6, lines 11-19; p. 7, line 7 to p. 8, line 7; and FIGS. 1-3. The side shield 22 covers the entire first side surface 52 of the roll 50, wherein the side shield 22 is movable between a closed configuration (FIGS. 1, 3 & 4) and an open configuration (FIG. 2), wherein the side shield 22 forms a concave shape facing the roll 50 when in the closed configuration, the concave shape defining a volume and the roll 50 occupying at least a portion of the volume, and further wherein the side shield 22 forms a convex shape facing the roll 50 when in the open configuration. *See also*, Specification, p. 6, line 28 to p. 7, line 6.

The method recited in claim 18 also recites moving the side shield 22 from the closed configuration (FIG. 1) to the open configuration (FIG. 2); unrolling a selected portion of the continuous length product from the roll 50; and separating the selected portion of the continuous length product from the roll 50. *See* Specification, p. 8, line 27 to p. 9, line 6.

Claim 19 depends from claim 18 and recites that the side shield 22 is biased in either the open configuration (FIG. 2) or the closed configuration (FIGS. 1, 3 & 4), whereby a force is required when moving the side shield 22 from the closed configuration to the open configuration. *See Specification*, p. 6, line 28 to p. 7, line 6; p. 8, line 27 to p. 9, line 17.

Claim 20 depends from claim 18 and recites that the retaining plug 24 is friction fit within the central void 58 and wherein the method involves pushing the retaining plug 24 into the central void 58. *See Specification*, p. 7, lines 7-16 and FIG. 3.

Claim 21 depends from claim 18 and recites providing a second dispenser guard 30 with a retaining plug 34 protruding from a side shield 32, wherein the side shield 32 of the second dispenser guard 30 covers the entire second side surface 54 of the roll 50 when the retaining plug 34 of the second dispenser guard 30 is located within the central void 58. *See Specification*, p. 6, lines 11-19; p. 7, line 7 to p. 8, line 7; and FIGS. 1-3.

Claim 22 depends from claim 21 and recites that at least one of the retaining plug 24 of the first dispenser guard 20 and the retaining plug 34 of the second dispenser guard 30 is friction fit within the central void 58, and wherein the method involves pushing the friction fit retaining plug into the central void 58. *See Specification*, p. 7, lines 7-16 and FIG. 3.

Claim 23 depends from claim 21 and recites attaching the retaining plug 24 of the first dispenser guard 20 to the retaining plug 34 of the second dispenser guard 30. *See Specification*, p. 7, lines 14-16 and FIG. 2.

Claim 24 depends from claim 21 and recites that the side shield 22 of the first dispenser guard 20 and the side shield 32 of the second dispenser guard 30 form an enclosed volume containing the roll 50. *See Specification*, p. 6, line 28 to p. 7, line 2 and FIGS. 1 & 3.

Claim 25 depends from claim 18 and recites that the continuous length product 50 is adhesive tape. *See Specification*, p. 5, lines 25-27 and FIGS. 3 & 4.

Independent method claim 26 recites a method of dispensing continuous length product from a roll 50, the method including providing a roll 50 of continuous length product with opposing first and second side surfaces 52 & 54 defining a roll diameter and a core 56 defining a central void 58 within the roll 50. *See Specification*, p. 5, lines 19-24 and FIGS. 1-3. The

method includes providing a first dispenser guard 20 with a first retaining plug 24 protruding from a first side shield 22, wherein the first side shield 22 covers the first side surface 52 of the roll 50 when the first retaining plug 24 is located within the central void 58. *See* Specification, p. 6, lines 11-19; p. 7, line 7 to p. 8, line 7; and FIGS. 1-3. The first side shield 22 is movable between a closed configuration (FIGS. 1 & 3) and an open configuration (FIG. 2), wherein the first side shield 22 forms a concave shape facing the first side surface 52 of the roll 50 when in the closed configuration, the concave shape defining a volume, and further wherein the roll 50 occupies at least a portion of the volume. *See also*, Specification, p. 6, line 28 to p. 7, line 6.

The method of claim 26 also includes providing a second dispenser guard 30 including a second retaining plug 34 protruding from a second side shield 32, wherein the second side shield 32 covers the second side surface 54 of the roll 50 when the second retaining plug 34 is located within the central void 58. *See* Specification, p. 6, lines 11-19; p. 7, line 7 to p. 8, line 7; and FIGS. 1-3. The second side shield 32 is movable between a closed configuration (FIGS. 1 & 3) and an open configuration (FIG. 2), wherein the second side shield 32 forms a concave shape facing the second side surface 54 of the roll 50 when in the closed configuration, the concave shape defining a volume, and further wherein the roll 50 occupies at least a portion of the volume. *See also*, Specification, p. 6, line 28 to p. 7, line 6.

The method of claim 26 further includes moving the first side shield 22 from the closed configuration (FIGS. 1 & 3) to the open configuration (FIG. 2), moving the second side shield 32 from the closed configuration (FIGS. 1 & 3) to the open configuration (FIG. 2), unrolling a selected portion of the continuous length product from the roll 50, and separating the selected portion of the continuous length product from the roll 50. *See* Specification, p. 8, line 27 to p. 9, line 6.

Claim 27 depends from claim 26 and recites that the first side shield 22 is biased in either the open configuration (FIG. 2) or the closed configuration (FIGS. 1 & 3), whereby a force is required when moving the first side shield 22 from the closed configuration to the open configuration, and further wherein the second side shield 32 is biased in either the open configuration (FIG. 2) or the closed configuration (FIGS. 1 & 3), whereby a force is required

when moving the second side shield 32 from the closed configuration to the open configuration. *See* Specification, p. 6, line 28 to p. 7, line 6; p. 8, line 27 to p. 9, line 17.

Claim 28 depends from claim 26 and recites that the first side shield 22 forms a convex shape facing the first side surface 52 of the roll 50 when in the open configuration, and further wherein the second side shield 32 forms a convex shape facing the second side surface 54 of the roll 50 when in the open configuration. *See* Specification, p. 6, line 28 to p. 7, line 6.

Claim 29 depends from claim 26 and recites that at least one of the first retaining plug 24 and the second retaining plug 34 is friction fit within the central void 58, and wherein the method involves pushing the friction fit retaining plug into the central void 58. *See* Specification, p. 7, lines 7-16 and FIG. 3.

Claim 30 recites attaching the first retaining plug 24 to the second retaining plug 34. *See* Specification, p. 7, lines 14-16 and FIG. 2.

Claim 31 depends from claim 26 and recites that the first side shield 22 and the second side shield 32 form an enclosed volume containing the roll 50 when both the first side shield 32 and the second side shield 32 are in their respective closed configurations. *See* Specification, p. 6, line 28 to p. 7, line 2 and FIGS. 1 & 3.

Claim 32 depends from claim 26 and recites that the continuous length product 50 is adhesive tape. *See* Specification, p. 5, lines 25-27 and FIGS. 3 & 4.

VI. ISSUES PRESENTED FOR REVIEW

A. Whether, under 35 U.S.C. § 112, first paragraph, claims 1-32 contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

B. Whether, under 35 U.S.C. § 103, claims 1-32 are unpatentable as obvious over U.S. Patent No. 474,518 to Bishop.

VII. GROUPING OF CLAIMS

For the purpose of this appeal, claims 1-32 stand or fall together.

VIII. ARGUMENT

A. The inventions recited in claims 1-32 are described in the specification in a manner such that one of ordinary skill in the art can make or use the invention.

Claims 1-32 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the relevant art to make and/or use the invention. Applicants disagree with this rejection and request reversal by the Board.

This rejection is premised on the assertion that it is not clear how the side shields of the roll goods dispenser system are movable between the closed and open configurations.

Applicants traverse this rejection and submit that claims 1-32 meet the requirements of 35 U.S.C. § 112, first paragraph. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *See In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988) (*cited by* MPEP § 2164.01(a), pp. 2100-178 to 2100-180 (8th Ed., Rev. 1, Feb. 2003)). An enablement rejection should provide the "factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation" MPEP § 2164.01(a), pp. 2100-183 (8th Ed., Rev. 1, Feb. 2003) (emphasis in original).

In support of the rejection, the Examiner has asserted that "[i]t is not clear what kind of force is required and how the force is to be applied." While these assertions may be an attempt to provide some of the reasons as to why the Examiner concludes that the specification fails to teach how to use the invention, they do not address why the Examiner believes that one of ordinary skill would not be able to determine how to use the invention without undue experimentation. The failure to provide any evidence or reasoning on that point alone indicates that the Examiner has not met his burden in establishing a *prima facie* case of non-enablement.

Furthermore, Applicants note that the Examiner has not addressed the teachings in the specification that do discuss a variety of methods of how to use the invention. Those teachings go directly to indicating how the invention is to be used and have never been acknowledged or addressed by the Examiner. Applicants now respectfully direct the Board's attention to the following excerpt from the specification:

In some instances, the side shields 22 and 32 may be closed by first placing the roll goods dispenser system 10 on a flat surface with side shield 22 laid flat on the surface, and then exerting a force on the side shield 32 such that the force returns the side shield 32 directly to the closed position, and returns the side shield 22 to the closed position by compressing the system 10 against the flat surface.
Specification, p. 9, lines 9-14.

In the above excerpt, the specification indicates that a compressive force (i.e., the "kind of force") is to be used to close the device, and that the compressive force is to be applied to the sides of the device (i.e., "how the force is to be applied"). As indicated above, however, the Examiner has not addressed these teachings.

Furthermore, Applicants submit that in a predictable art area such as that of the present invention, one of ordinary skill in the art would be able to determine how to open the device based on the above excerpt, all of the teachings of the specification, and the knowledge of one of ordinary skill in the art as evidenced by, e.g., the patents cited during prosecution of this application. *See, e.g.* MPEP § 2164.03, p. 2100-182 (8th Ed., Rev. 1, Feb. 2003). Those teachings include the figures, which clearly depict the device in its open and closed configurations.

In addition, the types of elastomeric materials used in the present invention as described in the Specification and serve to further illustrate to one of ordinary skill in the art how the side shields are movable from the closed configuration to the open configuration. Examples of suitable materials described in the Specification include SANTOPRENE, made by Advanced Elastomer Systems, L.P. of Akron, OH; rubber; ULTRATHANE UE 630 Nat., made by Futura Coatings, Inc. of St. Louis, MO; DOWLEX 2517 Nat., made by Dow Chemical Co. of Midland,

MI; SARLINK 3180 Nat., made by DSM Thermoplastic Elastomers, Inc. of Leominster, MA; and urethane. *See* Specification, page 6, lines 11-17.

Applicants' position on the well-known nature of the materials and the physics surrounding the use of these materials in cup-shaped devices is supported by the patent references cited by the Applicants during prosecution. For example, U.S. Patent Nos. 404,501 (Pfanne); 2,452,225 (Coloccia); 2,555,933 (Renstrom); 2,713,864 (Solomon); and 5,076,299 (Wistrand) all disclose devices with flexible elastomeric cup-shaped portions and methods of using the same. These patents are all attached in Appendix B.

Applicants submit that one of ordinary skill in the art understands the physical properties of these well-known materials used to manufacture the device (e.g., the elastomeric materials used for the sides) and how they would react to the application of a variety of forces, e.g., compression, tension, bending, etc. As a result, Applicants respectfully submit that one of ordinary skill in the art would be able to determine how the side shields are movable from the closed configuration to the open configuration. Finally, the Examiner has failed to provide any reasoning or evidence as to why one of ordinary skill in the art would be able to use the invention without undue experimentation as required for a proper enablement rejection under 35 U.S.C. § 112.

For at least the above reasons, Applicants submit that claims 1-32 meet the requirements of 35 U.S.C. § 112, first paragraph. Review and reversal of this rejection by the Board are, therefore, respectfully requested.

B. The inventions recited in claims 23 and 24 are patentable over U.S. Patent No. 474,518 to Bishop under 35 U.S.C. § 103.

Claims 1-32 stand rejected under 35 U.S.C. § 103 as being obvious in view of Bishop (U.S. Patent No. 474,518) (copy attached in Appendix C). Applicants respectfully disagree with this rejection and respectfully request reversal by the Board.

This rejection is premised on the assertion that the side shields (A) of Bishop are concave in the same way as Applicant's device. In support of the rejection, it is asserted that the shields (A) can be removed from the core and positioned with the outside walls facing the roll, therefore forming a convex shape facing the roll. The Examiner also asserts that there is friction between the plugs (B) and core (C) (as opposed to being frictionless) therefore forming a "friction fit." All the pieces are attached together as shown in the figures. The Examiner further alleges that adhesive tape would have been an obvious choice of material to be used in conjunction with the apparatus, which would facilitate the device opening to facilitate dispensing, if desired.

Applicants traverse this rejection as failing to meet the requirements for a *prima facie* case of obviousness. Specifically, the Office Action fails to present a proper motivation or suggestion to modify the teachings of Bishop as asserted.

The Office Action alleges that end pieces (A) of Bishop "can be removed from the core and positioned with the outside walls facing the roll therefore forming a convex shape facing the roll." Applicants first note that there is no motivation or suggestion identified in the prior art to make such a modification in Bishop. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01, p. 2110-126 (8th Ed., Rev. 1, Feb. 2003) (*citing In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)). No portion of Bishop has ever been identified as providing support for a finding that the proposed modification would be desirable.

Furthermore, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984) (*cited by* MPEP § 2143.01, pp. 2100-127 (8th Ed., Rev. 1, Feb. 2003)). Modifying Bishop in the proposed manner would render the device taught by Bishop unsatisfactory for its intended purpose, thus negating the asserted motivation or suggestion required for a *prima facie* case of obviousness.

For example, turning one or both end pieces (A) around would leave the ribbon exposed to external elements and possible damage. This is in direct contrast to the teachings of Bishop, where the case is "designed to furnish a neat package for the ribbon, to completely protect it from

damage, rough handling or the oxidizing effect of the atmosphere." *See* Bishop, page 1, lines 7-10.

Furthermore, turning one of both of the end pieces of Bishop around as asserted would also result in the lugs (B) facing away from the core or bobbin on which the ribbon is wound. As discussed in Bishop, the lugs (B) are provided to support the core or bobbin. Providing them on the outside of the end pieces (A) would result in the core or bobbin being unsupported. If unsupported, the ribbon would not be retained within the end pieces, thereby further subjecting it to damage.

Turning one or both end pieces (A) around as asserted would, therefore, render Bishop unsatisfactory for its intended purpose of protecting ribbon from damage and oxidation, thereby negating the asserted motivation or suggestion to modify Bishop to reach a *prima facie* case of obviousness.

Finally, the Bishop device includes a slot (a' in Figure 1) through which the ribbon is dispensed, thus obviating the need to open the container to remove ribbon therefrom.

For at least the above reasons, Applicants submit that claims 1-32 are not *prima facie* obvious in view of Bishop. Review and reversal of this rejection by the Board are respectfully requested.

Appellants' Brief on Appeal

Serial No.: 09/818,240

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For: ROLL GOODS DISPENSER SYSTEM AND METHODS OF USE

Page 15 of 15

IX. SUMMARY

It is respectfully submitted that all of pending claims 1-32 are patentable. It is earnestly requested that the Board reverse the Examiner's rejections of claims 1-32, and that all of the claims be allowed.

Respectfully submitted for

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By: 

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